

### REMARKS

The Examiner rejected claims 1-8, 11, and 13-15, while withdrawing claims 9, 10, 12, and 16-50 from further consideration. Claims 11, 12, and 18-50 have been cancelled herein without prejudice. Thus, claims 1-10 and 13-17 are pending.

Claims 1, 7, 9, 10, 14, 15, and 17 have been amended herein to recite labeled RNA molecules. Applicants' specification fully supports these amendments. For example, page 6, lines 6-13 disclose that the labeled nucleic acid molecules can be labeled RNA molecules. See, also, originally presented claim 11. Thus, no new matter has been added.

In light of these amendments and the following remarks, Applicants respectfully request reconsideration and allowance of claims 1-8 and 13-15. Applicants also respectfully request rejoinder and allowance of claims 9, 10, 16, and 17.

#### Rejection under 35 U.S.C. § 102(b)

The Examiner rejected claims 1-3, 6, and 13-15 under 35 U.S.C. § 102(b) as allegedly being anticipated by the Wagner *et al.* reference (*PNAS*, 95:14447-14452 (1998)). The Examiner also rejected claims 1-3, 6, and 13-15 under 35 U.S.C. § 102(b) as allegedly being anticipated by the Yoshida *et al.* reference (*Immunogenetics*, 52:35-45 (2000)). In addition, the Examiner rejected claims 1-3, 6, 7, and 13-15 under 35 U.S.C. § 102(b) as allegedly being anticipated by the Lebed *et al.* reference (*J. Biomol. Struct. Dynam.*, 18:813-823 (2001)).

Applicants respectfully disagree. To further prosecution, however, Applicants have amended independent claim 1 to recite labeled RNA molecules, which were recited in presently cancelled claim 11. Applicants note that previously presented claim 11 was not included in these rejections. Thus, these rejections are moot.

In light of the above, Applicants respectfully request withdrawal of the rejection of claims 1-3, 6, 7, and 13-15 under 35 U.S.C. § 102(b).

#### Rejection under 35 U.S.C. § 103(a)

The Examiner rejected claims 4, 5, 7, and 8 under 35 U.S.C. § 103(a) as allegedly being

unpatentable over the Wagner *et al.* reference (*PNAS*, 95:14447-14452 (1998)) and the Fulton *et al.* reference (*Clin. Chem.*, 43:1749-1756 (1997)). The Examiner also rejected claims 4, 5, 7, and 8 under 35 U.S.C. § 103(a) as allegedly being unpatentable over the Yoshida *et al.* reference (*Immunogenetics*, 52:35-45 (2000)) and the Fulton *et al.* reference (*Clin. Chem.*, 43:1749-1756 (1997)). In addition, the Examiner rejected claim 8 under 35 U.S.C. § 103(a) as allegedly being unpatentable over the Lebed *et al.* reference (*J. Biomol. Struct. Dynam.*, 18:813-823 (2001)) as evidenced by U.S. Patent No. 6,017,710.

Applicants respectfully disagree. To further prosecution, however, Applicants have amended independent claim 1 to recite labeled RNA molecules, which were recited in presently cancelled claim 11. Applicants note that previously presented claim 11 was not included in these rejections. Thus, these rejections are moot.

In light of the above, Applicants respectfully request withdrawal of the rejections of claims 1, 4, 7, and 8 under 35 U.S.C. § 103(a).

Further, the Examiner rejected claim 11 under 35 U.S.C. § 103(a) as allegedly being unpatentable over the Lebed *et al.* reference (*J. Biomol. Struct. Dynam.*, 18:813-823 (2001)) and the Wang *et al.* reference (*Nature Biotechnology*, 18:457-459 (2000)). In particular, after acknowledging that the Lebed *et al.* reference does not disclose RNA molecules, the Examiner stated that the Wang *et al.* reference teaches hybridization of labeled RNA molecules to DNA chips. The Examiner also apparently believes that the Wang *et al.* reference provides motivation to replace the labeled DNA molecules of the Lebed *et al.* reference with the labeled RNA molecules of the Wang *et al.* reference, stating that “using RNA molecules permitted detection of low-abundance mRNAs and clinical samples.”

Applicants respectfully disagree. The Lebed *et al.* reference discloses analyzing complex mixtures of DNA fragments. As disclosed on page 818, Lebed *et al.* used V8.3-C $\beta$  PCR products that were converted to ssDNA and fragmented to increase the efficiency of hybridization of the DNA with a microchip. At no point does the Lebed *et al.* reference disclose either the use of labeled RNA molecules or the need for using labeled RNA molecules. Moreover, at no point does the Lebed *et al.* reference disclose that RNA molecules are needed to

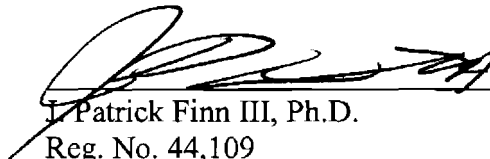
permit the detection of low-abundance mRNAs. Thus, a person having ordinary skill in the art would not have been motivated as the Examiner appears to suggest. As such, the presently amended claims are patentable over the cited references.

### CONCLUSION

Applicants respectfully assert that claims 1-10 and 13-17 are in condition for allowance, which action is requested. The Examiner is invited to telephone the undersigned attorney if such would expedite prosecution. Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: October 17, 2008

  
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